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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,151	06/26/2003	Charles P. Gilliam	111325-450100	3546
22204 7590 09/08/2008 NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER SONG, HOSUK	
			ART UNIT 2135	PAPER NUMBER
			MAIL DATE 09/08/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/606,151

Applicant(s)

GILLIAM ET AL.

Examiner

HOSUK SONG

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-146 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-146 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-850)
Paper No(s)/Mail Date 11/6/03/7/6/04/2/19/08/7/2/08
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2,4-15,17-26,28-39,41-52,54-66,68-87,89-101,103-146 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyman(US 5,438,508).

Claims 1,4,6,8-10: Wyman disclose condition for use of item by recipient, condition indicating use of item by recipient subject to control by a stakeholder in (col.20,lines 36-47). Wyman does not specifically disclose specifying by a provider of an item a rights expression. It would have been obvious to person of ordinary skill in the art to modify the invention of Wyman to include rights expression in order to minimize misuse or tampering by the recipient so that recipient is informed of customer's right to access and right to entitlement and refrain from committing an illegal activities.

Claim 2: Wyman disclose obtaining permission for use of item by a first repository from a second repository and controlling second repository by stakeholder to control use of item by recipient in (fig.1).

Claim 5: Wyman disclose condition specified by stakeholder use of item by recipient is subject to authorization by a stakeholder in (col.20,lines 36-47).

Claim 7: Wyman disclose indicating at least one of respective conditions indicating that use of item by recipient is subject to respective conditions of a plurality of stakeholders in (col.33,lines 45-63).

Claim 11-14: Wyman disclose master license in (fig.1,4).

Claim 15: Wyman disclose accessing one or more pointer to reference one or more pointers to master license to perform checking step in (fig.4,7).

Claims 17-20: Wyman disclose employing a central control repository that at least one of references rights expression and is referenced by item , central control repository including at latest version of rights expression; checking central control repository for latest version of rights expression and controlling central control repository by stakeholder to control use of item by recipient in (fig.7 and col.7,lines 42-45).

Claim 21: Wyman disclose usage right in (col.33,lines 58-61).

Claim 22: Wyman disclose access to item in (fig.7).

Claim 23: Wyman disclose recipient includes at least one of a user of item, a distributor of item and a consumer of item in (col.20,lines 62-67).

Claim 24: Wyman disclose item includes at least one of digital content, digital goods, digital services, non-digital content, non-digital goods and non-digital services in (col.10,lines 46-50).

Claims 25,28,30,32-36,44: Wyman disclose condition for use of item by recipient, condition indicating use of item by recipient subject to control by a stakeholder in (col.20,lines 36-47). Wyman does not specifically disclose specifying by a provider of an item a rights expression. It would have been obvious to person of ordinary skill in the art to modify the invention of Wyman to include rights expression in order to minimize misuse or tampering by the recipient so that recipient is informed of customer's right to access and right to entitlement and refrain from committing an illegal activities.

Claim 26: Wyman disclose obtaining permission for use of item by a first repository from a second repository and controlling second repository by stakeholder to control use of item by recipient in (fig.1).

Claim 29: Wyman disclose condition specified by a stakeholder use of item by recipient is subject to authorization by a stakeholder in (col.20,lines 36-47).

Claim 31: Wyman disclose condition specified by a stakeholder use of item by recipient is subject to authorization by a stakeholder in (col.20,lines 37-47).

Claim 37: Wyman disclose master license in (fig.1,4).

Claims 38-39: Wyman disclose accessing one or more pointer to reference one or more pointers to master license to perform checking step in (fig.4,7).

Claims 41-43: Wyman disclose employing a central control repository that at least one of references rights expression and is referenced by item , central control repository including at latest version of rights expression; checking central control repository for latest version of rights expression and controlling central control repository by stakeholder to control use of item by recipient in (fig.7 and col.7,lines 42-45).

Claim 45: Wyman disclose usage right in (col.33,lines 58-61).

Claim 46: Wyman disclose access to item in (fig.7).

Claim 47: Wyman disclose recipient includes at least one of a user of item, a distributor of item and a consumer of item in (col.20,lines 62-67).

Claim 48: Wyman disclose item includes at least one of digital content, digital goods, digital services, non-digital content, non-digital goods and non-digital services in (col.10,lines 46-50).

Claims 49-50: Wyman disclose specifying means for associating and means for controlling comprises computer readable instructions recorded on a computer readable medium in (fig.7).

Claims 51,54-56,58-60,79-84: Wyman disclose condition for use of item by recipient, condition indicating use of item by recipient subject to control by a stakeholder in (col.20,lines 36-47). Wyman does not specifically disclose specifying by a provider of an item a rights expression. It would have been obvious to person of ordinary skill in the art to modify the invention of Wyman to include rights expression in order to minimize misuse or tampering by the recipient so that recipient is informed of customer's right to access and right to entitlement and refrain from committing an illegal activities.

Claim 52: Wyman disclose obtaining permission for use of item by a first repository from a second repository and controlling second repository by stakeholder to control use of item by recipient in (fig.1).

Claim 57: Wyman disclose indicating at least one of respective conditions indicating that use of item by recipient is subject to respective conditions of a plurality of stakeholders in (col.33,lines 45-63).

Claims 61-64: Wyman disclose master license and controlling the use of item by the provider in (fig.1,4).

Claims 65-66: Wyman disclose accessing one or more pointer to reference one or more pointers to master license to perform checking step in (fig.4,7).

Claims 68-72: Wyman disclose employing a central control repository that at least one of references rights expression and is referenced by item , central control repository including at latest version of rights expression; checking central control repository for latest version of rights expression and controlling central control repository by stakeholder to control use of item by recipient in (fig.7 and col.7,lines 42-45).

Claim 73: Wyman disclose usage right in (col.33,lines 58-61).

Claim 74: Wyman disclose access to item in (fig.7).

Claim 75-78: Wyman disclose recipient includes at least one of a user of item, a distributor of item and a consumer of item in (col.20,lines 62-67).

Claim 85: Wyman disclose item includes at least one of digital content, digital goods , digital services, non-digital content, non-digital goods and non-digital services in (col.10,lines 46-50).

Claims 86,89,91-95,111-119: Wyman disclose condition for use of item by recipient, condition indicating use of item by recipient subject to control by a stakeholder in (col.20,lines 36-47). Wyman does not specifically disclose specifying by a provider of an item a rights expression. It would have been obvious to person of ordinary skill in the art to modify the invention of Wyman to include rights

Art Unit: 2135

expression in order to minimize misuse or tampering by the recipient so that recipient is informed of customer's right to access and right to entitlement and refrain from committing an illegal activities.

Claim 87: Wyman disclose obtaining permission for use of item by a first repository from a second repository and controlling second repository by stakeholder to control use of item by recipient in (fig.1).

Claim 90: Wyman disclose indicating at least one of respective conditions indicating that use of item by recipient is subject to respective conditions of a plurality of stakeholders in (col.33,lines 45-63).

Claims 96-99: Wyman disclose employing master license that at least one of references rights expression and is referenced by item, including a latest version of rights expression and checking master license for latest version of rights expression and controlling master license by provider to control use of item by recipient in (fig.1,4).

Claims 100-101: Wyman disclose accessing one or more pointer to reference one or more pointers to master license to perform checking step in (fig.4,7).

Claims 103-107: Wyman disclose employing a central control repository that at least one of references rights expression and is referenced by item , central control repository including at latest version of rights expression; checking central control repository for latest version of rights expression and controlling central control repository by stakeholder to control use of item by recipient in (fig.7 and col.7,lines 42-45).

Claim 108: Wyman disclose usage right in (col.33,lines 58-61).

Claim 109: Wyman disclose access to item in (fig.7).

Claim 110: Wyman disclose recipient includes at least one of a user of item, a distributor of item and a consumer of item in (col.20,lines 62-67).

Claim 120: Wyman disclose item includes at least one of digital content, digital goods, digital services, non-digital content, non-digital goods and non-digital services in (col.10,lines 46-50).

Claim 121-122: Wyman disclose specifying means for associating and means for controlling comprises computer readable instructions recorded on a computer readable medium in (fig.7).

Claims 123-133: Wyman disclose condition for use of item by recipient, condition indicating use of item by recipient subject to control by a stakeholder in (col.20,lines 36-47). Wyman does not specifically disclose specifying by a provider of an item a rights expression. It would have been obvious to person of ordinary skill in the art to modify the invention of Wyman to include rights expression in order to minimize misuse or tampering by the recipient so that recipient is informed of customer's right to access and right to entitlement and refrain from committing an illegal activities.

Claims 134-146: See claims rejection 123-133 above.

Claims 3,27,53,88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyman(US 5,438,508) in view of Terao et al(US 6,690,794).

Claims 3,27,53,88: Wyman does not specifically disclose digital ticket that references rights expression. Terao disclose this limitation in (fig.2). It would have been obvious to person of ordinary skill in the art at the time invention was made to employ digital ticket as taught in Terao with system of Wyman in order to control data distribution and prevent replay attacks.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-146 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-24,50-85,123-133: The invention as claimed does not pertain to a tangible product as the recitation of the method denotes. For such claims to be statutory they must be embodied within a tangible computer medium such as hard drives or some other computer hardware form.

Claims 25-49,86-122,134-146 directed to a system for controlling a rights expression specifying use of an item. Claimed system must include hardware to realize any of the functionality of the claims and produce a useful, concrete and tangible result. Absent recitation of such hardware as part of the claimed system, it is considered non-statutory.

Claims 1-146: The claimed invention does not produce a useful, concrete, and tangible result. The controlling by stakeholder use of item by recipient based on condition in rights expression is not sufficient to satisfy the requirements of U.S.C 101 requiring that a process produce a useful, concrete and tangible result.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-3,26-27,52-53,87-88,123,134 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language like “permission” or “allowing” are indefinite. It's unclear what Applicant's intended metes and bounds of the claim are, since the claim appears to cover anything and everything that does not prohibit actions from occurring.

Allowable Subject Matter

Claims 16,40,67,102 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HOSUK SONG whose telephone number is 5712723857. The examiner can normally be reached on mon-fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KIM VU can be reached on 5712723859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HOSUK SONG/
Primary Examiner, Art Unit 2135